

## REMARKS

The Office Action of November 13, 2008 was received and carefully reviewed. Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claims 1-19 were pending prior to the instant amendment. By this amendment, claims 1-8 are amended. Consequently, claims 1-19 are currently pending in the instant application with claims 1-8 being independent.

In the Office Action, claims 1-8 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, Applicants have amended claims 1-8 to recite the feature of “the first conductive is thicker than the second conductive layer in a vertical direction.” Thus, in light of the above amendment, Applicants respectfully request that the 112 rejection be withdrawn.

Additionally, claims 1-2, 10 and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. Pub. 2002/0089616 to Hashimoto et al. (Hashimoto) and claims 3-8, 16 and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,365,917 to Yamazaki (Yamazaki ‘917). Hashimoto and/or Yamazaki ‘917, however, fail to render the claimed invention unpatentable. Each of the claims recite a specific combination of features that distinguishes the invention from the prior art in different ways. For example, amended independent claims 1-8, as amended, each similarly recite a combination that includes, among other things:

a first conductive layer fitted in the (first) opening ... wherein a surface of the (first) insulating layer and the first conductive layer is planarized.

(See, for example, FIG. 18A and page 49, line 23 to page 50, line 7 of application). Independent claims 3, 4, 7 and 8, as amended, further recite yet another combination that includes, *inter alia*,

a fourth conductive layer fitted in the second opening.

(See, for example, FIG. 46 of application). At the very least, Hashimoto and/or Yamazaki ‘917 fail to disclose or suggest any of these exemplary features recited in the independent claims 1-8.

To establish anticipation under 35 U.S.C. § 102(b), the Examiner must show that each and every feature recited in these claims is either explicitly disclosed or “necessarily present” in a single prior art reference, such as within the four corners of the Hashimoto and/or Yamazaki ‘917 references. *See M.P.E.P. § 2131(7<sup>th</sup> ed. 1998); In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). To support a conclusion of anticipation, the Examiner must specifically identify “substantial evidence” setting forth why and how the single prior art reference anticipates each and every feature recited in the claims. *See In re Mullin*, 481 F.2d 1333, 1336-37 (CCPA 1973) (An Examiner’s bare assertion that claims were obviously anticipated by a reference did not inform the Applicant as to why the claims lacked novelty); *Dickinson v. Zurko*, 527, U.S. 150 (1999) (The U.S. Patent Office’s findings of fact must be reviewed by the substantial evidence standard).

Viewed against this backdrop, each of the Examiner’s factual conclusions must be supported by “substantial evidence” in the documentary record. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of

fact necessary to support a conclusion of anticipation or obviousness “less to ‘haze of so-called expertise’ acquire insulation from accountability.” *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b). In this case, however, the Examiner cannot satisfy his burden of demonstrating how Hashimoto and/or Yamazaki ‘917, taken alone or in combination with any other prior art reference, can either render obvious each and every one of the limitations present in independent claims 1-8 as required by the Manual of Patent Examining Procedure (“MPEP”) and Federal Circuit jurisprudence.

The Examiner asserts that Hashimoto “discloses in figure 5, a thin film transistor comprising: an insulating layer (see Fig. 5) having a first opening; a first conductive layer 12B in the first opening; a second conductive layer 4p on and in contact with the first insulating layer and the first conductive layer 12B; wherein the first conductive layer 12B is wider and thicker than the second conductive layer 4p.” Further, the Examiner asserts that Yamazaki “discloses in figures 1-23B, a display device comprising: a first insulating layer 103 having a first opening; a first conductive layer 112 in the first opening (Fig. 9A); a second conductive layer (plug connected to 112 in Fig. 9A) on and in contact with the first insulating layer 103 and the first conductive layer 112; a semiconductor layer 107 over the second conductive layer with a gate insulating film there between (Fig. 9A); a third conductive layer 36/1704 over the semiconductor layer 107 (Fig. 9A-C & 17); a second insulating layer 1711 having an opening over the third conductive layer 36/1704 (fig. 17); and a fourth conductive layer 1714 in the second opening; wherein the first conductive layer 112 is wider and thicker than the second conductive layer, wherein the fourth conductive layer 1714 is thicker than the third conductive layer 1704.”

However, as shown above, Applicants have amended claims 1-8 to recite, *inter alia*, the features a first conductive layer fitted in the (first) opening and a surface of the (first) insulating layer and the first conductive layer is planarized. That is, it appears that neither Hashimoto nor Yamazaki ‘917 teach or disclose the features of a first conductive layer fitted in the (first) opening and a surface of the (first) insulating layer and the first conductive layer is planarized, as presently claimed.

For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claims are not found either expressly or inherently described as required by the M.P.E.P., Hashimoto and/or Yamazaki ‘917 cannot be said to anticipate the invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Further, claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto as applied to claim 1 above, and in view of U.S. Patent No. 5,329,390 to Fujiwara et al. (Fujiwara); claims 11-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki ‘917 as applied to claim 8 above, and in view of U.S. Pat. Pub. 2002/0132396 to Yamazaki et al. (Yamazaki ‘396); claims 13 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki ‘917 as applied to claim 8 above; and claims 14-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki ‘917 as applied to claim 8 above, and in further view of U.S. Pat. Pub. 2001/0013913 to Young (Young). These rejections are traversed as discussed in detail below.

The Examiner has failed to establish a *prima facie* case of obviousness for at least the following reasons. First, the Examiner has not demonstrated how Hashimoto and/or Yamazaki ‘917 along with Fujiwara, Yamazaki ‘396 and/or Young, whether taken alone or in

combination, disclose or suggest each and every feature recited in the claims. *See M.P.E.P. § 2143* (7th ed. 1998). Second, the Examiner has not shown the existence of any reasonable probability of success in modifying Hashimoto and/or Yamazaki ‘917, the base references, based on the teachings of Fujiwara, Yamazaki ‘396 and/or Young, the secondary references, in a manner that could somehow result in the claimed invention. *See id.*

Each of the Examiner’s factual conclusions must be supported by “substantial evidence” in the documentary record, as required by the Federal Circuit. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness “less the ‘haze of so-called expertise’ acquire insulation from accountability.” *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has failed to satisfy his burden of demonstrating how Hashimoto and/or Yamazaki ‘917, taken alone or in combination with Fujiwara, Yamazaki ‘396 and/or Young, can either anticipate or render obvious each and every one of the limitations present in independent claims 1-8, as required by the M.P.E.P. and Federal Circuit jurisprudence.

The Examiner attempts to remedy the deficiencies of Hashimoto and/or Yamazaki ‘917 by turning to Fujiwara, Yamazaki ‘396 and/or Young. However, the Fujiwara, Yamazaki ‘396 and/or Young references do not disclose or suggest the features of a first conductive layer fitted in the (first) opening and a surface of the (first) insulating layer and the first conductive layer is planarized, as recited in claims 1-8.

In accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a

claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully submitted that neither Hashimoto, Yamazaki ‘917, Fujiwara, Yamazaki ‘396 nor Young taken alone or in any proper combination, discloses or suggests the subject matter as recited in claims 1-8. Hence, withdrawal of the rejection is respectfully requested.

Each of the dependent claims depend from one of independent claims 1, 2, 3, 4, 5, 6, 7 or 8 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claims 1-8.

In addition, each of the dependent claims also recites combinations that are separately patentable.

In view of the foregoing remarks, this claimed invention, as amended, is not anticipated or rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this response, the Examiner’s reconsideration and reexamination of the application, and the timely allowance of the pending claims.

In discussing the specification, claims, and drawings in this response, it is to be understood that Applicants in no way intend to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned agent at (202) 585-8100.

Respectfully submitted,

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